

REMARKS

This is a full and timely response to the outstanding Office action mailed January 26, 2005. Upon entry of the amendments in this response claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are pending. More specifically, claims 1-3, 21, 22, 34-36, and 42 are amended. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application. Any other statements not explicitly addressed herein are not admitted.

I. Present Status of Patent Application

Claims 35-42 are rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter of a "computer readable medium per se." Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Arnold (U.S. Patent No. 6,275,848) in view of Jungck (U.S. Patent No. 6,728,785). Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Beyda *et al.* (U.S. Patent No. 6,275,850) in view of Gage *et al.* (U.S. Patent No. 5,923,846).

II. Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiners Phan and Thompson spent with Applicant's Attorneys Jeffrey Kuester and Benjamin Balser during a February 11, 2005 telephone discussion regarding the above-identified Office Action. Applicant believes that issues concerning an SMTP electronic mail message not disclosed in *Jungck* were identified during the telephone discussion, and that they are resolved herein. While Applicant agrees with the substance of the Interview Summary as submitted by the Examiner, Applicant respectfully submits that certain generalizations used by the Examiner could unfairly characterize the subject matter of the disclosure and should not be interpreted as a characterization by the Applicant. Generalizations include characterizing "the invention." The disclosure details many aspects pertaining to the subject matter of managing electronic mail messages. Describing one embodiment as "the invention" is unduly limiting and is contrary to

the intentions of Applicant. During that conversation, Examiners Phan and Thompson seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Phan carefully consider this amendment and response.

III. Rejections Under 35 U.S.C. §103(a)

A. Claims 1-3, 6-8, and 15

The Office Action rejects claims 1-3, 6-8, 15 under U.S.C. 103(a) as allegedly being anticipated by *Arnold* in view of *Jungck*. For the reasons set forth below, Applicant respectfully traverses the rejection. The Office Action also rejects claims 1-3, 6-8, and 15 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda et al.* in view of *Gage*. For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. (Currently Amended) A method for an Simple Mail Transfer Protocol (SMTP) electronic mail server application on a host computer, comprising the steps of:
checking an SMTP electronic mail message against a predetermined criteria; and
compacting a non-attachment portion of the SMTP electronic mail message if the predetermined criteria is satisfied.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicant respectfully submits that independent claim 21 as amended is allowable for at least the reason that *Arnold* and *Jungck* do not disclose, teach, or suggest at least **compacting a non-attachment portion of the SMTP electronic mail message**. Applicant respectfully submits that *Arnold* and *Jungck* discloses detaching an attachment to a message when the

message meets certain criteria. However, *Arnold* does not disclose compacting a non-attachment part of an SMTP electronic mail message. Additionally, *Jungck* discloses operations on a web page, but *Jungck* does not disclose an SMTP electronic mail message. Therefore, the combination of *Arnold* and *Jungck* does not disclose compacting a non-attachment portion of an SMTP electronic mail message, and the rejection should be withdrawn.

Additionally, *Beyda* and *Gage* cannot be combined to disclose compacting a non-attachment portion of an SMTP electronic mail message. *Beyda* discloses detaching an attachment when criteria are met. *Gage* discloses downloading a file from a bulletin board system (BBS). *Gage* does disclose compression of a rich text format (RTF) stream in a BBS using Messaging Application Programming Interface (MAPI) compression techniques. However, if the teaching of *Beyda* and *Gage* are combined, the result is a system where only RTF streams are compressed in every BBS message, and attached files are detached when certain criteria are met. Additionally, *Gage* only discloses the compression of a BBS message compliant with RFC-850 and RFC-1036. *Gage* does not disclose compression of an SMTP electronic mail message.

Because independent claim 1 as amended is allowable over *Beyda* and *Gage* and *Arnold* and *Jungck*, dependent claims 2-3, 6-8, and 15 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, and 15 contain all the steps/features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-3, 6-8, and 15 are patentable, the rejection to claims 2-3, 6-8, and 15 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, and 15 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 2-3, 6-8, and 15 are allowable.

B. Claims 21-23, 26-28, and 30-34

The Office Action rejects claims 21-23, and 26-28 under U.S.C. 103(a) as allegedly being anticipated by *Arnold* in view of *Jungck*. For the reasons set forth below, Applicant respectfully traverses the rejection. The Office Action also rejects claims 21-23, and 26-28 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda et al.* in view of *Gage*. For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21 recites:

21. A method for managing a user's Simple Mail Transfer Protocol (SMTP) electronic mailbox on a computer, comprising the steps of:

checking an SMTP electronic mail message against a predetermined criteria; and

compressing a non-attachment portion of the SMTP electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the SMTP electronic mail message is performed by searching for repeated patterns in the SMTP electronic mail message and encoding those patterns in an efficient manner.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicant respectfully submits that independent claim 21 as amended is allowable for at least the reason that *Arnold* and *Jungck* do not disclose, teach, or suggest at least **compacting a non-attachment portion of the SMTP electronic mail message**. Applicant respectfully submits that *Arnold* and *Jungck* discloses detaching an attachment to a message when the message meets certain criteria. However, *Arnold* does not disclose compacting a non-attachment part of an SMTP electronic mail message. Additionally, *Jungck* discloses operations on a web page, but *Jungck* does not disclose an SMTP electronic mail message. Therefore, the

combination of *Arnold* and *Jungck* does not disclose compacting a non-attachment portion of an SMTP electronic mail message, and the rejection should be withdrawn.

Additionally, *Beyda* and *Gage* cannot be combined to disclose compacting a non-attachment portion of an SMTP electronic mail message. *Beyda* discloses detaching an attachment when criteria are met. *Gage* discloses downloading a file from a bulletin board system (BBS). *Gage* does disclose compression of a rich text format (RTF) stream in a BBS using Messaging Application Programming Interface (MAPI) compression techniques. However, if the teaching of *Beyda* and *Gage* are combined, the result is a system where only RTF streams are compressed in every BBS message, and attached files are detached when certain criteria are met. Additionally, *Gage* only discloses the compression of a BBS message compliant with RFC-850 and RFC-1036. *Gage* does not disclose compression of an SMTP electronic mail message.

Because independent claim 21 as amended is allowable over *Beyda* and *Gage* and *Arnold* and *Jungck*, dependent claims 21-23, 26-28, and 30-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 21-23, 26-28, and 30-34 contain all the steps/features of independent claim 21. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 21-23, 26-28, and 30-34 are patentable over *Beyda* and *Gage* and *Arnold* and *Jungck*, the rejection to claims 21-23, 26-28, and 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 21-23, 26-28, and 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 21-23, 26-28, and 30-34 are allowable.

C. Claims 35-42

The Office Action rejects claims 35-42 under U.S.C. 103(a) as allegedly being anticipated by *Arnold* in view of *Jungck*. For the reasons set forth below, Applicant respectfully traverses the rejection. The Office Action also rejects claims 35-42 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda et al.* in view of *Gage*. For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 35 recites:

35. A computer readable medium with logic embedded therein for executing on a computer for managing a user's Simple Mail Transfer Protocol (SMTP) electronic mailbox on a computer comprising:

logic configured to screen an SMTP electronic mail message against a predetermined criteria; and

logic configured to, if the predetermined criteria is satisfied, ***compress a non-attachment portion of the SMTP electronic mail message by finding repeated patterns in the message and encoding those patterns.***

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicant respectfully submits that independent claim 35 as amended is allowable for at least the reason that *Arnold* and *Jungck* do not disclose, teach, or suggest at least **compress a non-attachment portion of the SMTP electronic mail message by finding repeated patterns in the message and encoding those patterns**. Applicant respectfully submits that *Arnold* and *Jungck* discloses detaching an attachment to a message when the message meets certain criteria. However, *Arnold* does not disclose compressing a non-attachment part of an SMTP electronic mail message. Additionally, *Jungck* discloses operations on a web page, but *Jungck* does not disclose an SMTP electronic mail message. Therefore, the combination of *Arnold* and *Jungck*

does not disclose compressing a non-attachment portion of an SMTP electronic mail message, and the rejection should be withdrawn.

Additionally, *Beyda* and *Gage* cannot be combined to disclose compressing a non-attachment portion of an SMTP electronic mail message. *Beyda* discloses detaching an attachment when criteria are met. *Gage* discloses downloading a file from a bulletin board system (BBS). *Gage* does disclose compression of a rich text format (RTF) stream in a BBS using Messaging Application Programming Interface (MAPI) compression techniques. However, if the teaching of *Beyda* and *Gage* are combined, the result is a system where only RTF streams are compressed in every BBS message, and attached files are detached when certain criteria are met. Additionally, *Gage* only discloses the compression of a BBS message compliant with RFC-850 and RFC-1036. *Gage* does not disclose compression of an SMTP electronic mail message.

Because independent claim 35 as amended is allowable over *Beyda* and *Gage* and *Arnold* and *Jungck*, dependent claims 36-42 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 contain all the steps/features of independent claim 21. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 36-42 are patentable over *Beyda* and *Gage* and *Arnold* and *Jungck*, the rejection to claims 36-42 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claims 36-42 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 36-42 are allowable.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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